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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,280	05/16/2001	Ralph C. Gray	1656A1	2673

7590 03/18/2003

PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/858,280

Applicant(s)

GRAY ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The election with traverse of Group I in Paper No. 4 is acknowledged. The traversal is on the grounds that the examination of Group will out of necessity include the aqueous composition of Group II and the organic solvent-based composition of Group III. This is not found persuasive because the separate classifications of Groups I, II and III establish a serious burden. The type of epoxy resin, curing agent and electroconductive pigment materially affects the classification of the claimed subject matter. For example, the election of an aminoplast curing agent places the examination in class 525, subclass 510, whereas the election of a polyisocyanate is placed in class 525, subclass 528.

The requirement is still deemed proper and is therefore made FINAL.

Claims 16-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction and election of species requirement in Paper No. 4. Claim 15 is withdrawn as being directed to the non-elected species of the composition with corrosion resistant pigments.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. and Young, Jr. et al. in view of Japanese Patent No. 7-331164.

Berger et al. (col. 8, lines 57-63) discloses a weldable coating composition comprising an epoxy-containing material (col. 9, lines 24-26) such as a diglycidyl ether of bisphenol A (col. 4, lines 10-18) in combination with aminoplasts or isocyanates as curing agents (col. 9, lines 27-28 and 49-58) and electroconductive pigments such as diiron phosphide (col. 8, lines 64-66).

Young, Jr. et al. espouses a weldable (col. 5, lines 63-64), an electroconductive primer coating (col. 7, lines 38-39) comprising an epoxy-containing material (col. 5, lines 8-12) such as bisphenol A-advanced diglycidyl ethers of bisphenol A (cols. 15-16, Table IV, Epon 1009), a Resimene or Cymel aminoplast curing agent (col. 5, lines 45-58 and Table IV) and an electroconductive pigment such as zinc or iron phosphides (col. 6, line 24).

The claimed reaction product of the epoxy-containing material with a phosphorus acid groups-containing compound is not recited. The Japanese patent teaches an epoxy resin modified with phosphoric acid, a curing agent and a pigment used as a coating for steel plates which are subsequently fabricated into articles.

It would have been obvious to modify the epoxy-containing materials of Berger et al. and Young, Jr. et al. via reaction with the phosphoric acid of the Japanese patent in order to improve the storage stability, adhesion, water resistance, coatability and fabrication properties (Japanese patent abstract, Advantage section).

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Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soltwedel.

Soltwedel (col. 4, lines 22-31) is directed to a weldable coating derived from a film-forming hydroxyl-functional polyester and epoxy resin, a mixture of blocked isocyanates and aminoplasts, and iron powder particles along with the reaction product of an epoxy resin and phosphoric acid as an adhesion promotor (col. 11, line 64 to col. 12, line 2).

The epoxy resin-phosphoric acid adduct adhesion promotor is not exemplified. It would have been obvious to formulate the weldable coating of Soltwedel with the epoxy resin-phosphoric acid adduct in order to enhance the adhesion to the metal substrate.

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Robert Sellers
Primary Examiner
Art Unit 1712

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3/10/03